

REMARKS

Summary of the Office Action

In the Office Action dated April 23, 2004, claims 1, 2, 4 and 8-10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,867,463 to Chiba (hereinafter "Chiba"). Claims 3 and 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiba in view of U.S. Patent No. 6,577,812 to Kikuchi et al. (hereinafter "Kikuchi").

Summary of the Response to the Office Action

Applicant traverses the rejections set forth in the Office Action and requests reconsideration. Applicant adds new claims 11 and 12. Accordingly, claims 1-12 are now pending in this application.

The Rejection under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

Claims 1, 2, 4 and 8-10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Chiba. Claims 3 and 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiba in view of Kikuchi. Applicant respectfully traverses this rejection for the following reasons.

Independent claim 1 recites a reproducing apparatus for a recording medium that includes "a memory for storing a plurality of setting parameters respectively associated with predetermined kinds of data contents." Applicant respectfully submits that Chiba does not teach or suggest a recording medium including at least the above-recited feature.

In embodiments of the instant invention, the “kinds of data contents”, as recited in the independent claim 1 and interpreted in light of the specification and drawings, refer for example to whether the data is voice, subtitles, dubbed audio, PCM data or MPEG video. See Specification at page 8, line 16 to page 9, line 12, and FIG. 4. In contrast, the recording and reproducing apparatus of Chiba, as cited to by the Office Action, merely stores control parameters DWT, DRP, DEP loaded in registers 108, 111 and 114 of a laser drive circuit, threshold values TU and TD loaded in registers 125 of the tracking fault detector 122, and data DGC held in register 138, as depicted in FIGs. 2-3 of Chiba. The control parameters of Chiba are not associated with predetermined kinds of data contents. Thus, Applicant respectfully submits that Chiba does not teach or suggest “storing a plurality of setting parameters respectively associated with predetermined kinds of data contents” as recited in independent claim 1.

Independent claim 1 further recites that a reproducing apparatus for a recording medium includes “a plurality of data contents which are related to an identical reproduction time of the reproduced content.” Applicant respectfully submits that Chiba does not teach or suggest the recording medium including such a plurality of data contents. In embodiments of the instant invention, as recited in independent claim 1, the data contents, for example, voice, dubbed audio and subtitles, are related to an identical reproduction time of the reproduced content. Applicant respectfully submits that Chiba does not teach or suggest “a plurality of data contents which are related to an identical reproduction time of the reproduced content.”

Independent claim 1 also recites that the reproducing apparatus for a recording medium includes “a discriminator for discriminating the data contents stored in the recording medium.” Applicant respectfully submits that Chiba does not teach or suggest the recording medium including at least a discriminator for discriminating the data contents stored in the recording medium. As set forth in the specification at pages 8-9, the kinds of data contents can be voice, subtitles, dubbed audio, PCM data or MPEG video. Thus in embodiments of the instant invention as recited independent claim 1, the discriminator discriminates whether the data contains voice, subtitles, dubbed audio, PCM data or MPEG video. In contrast, as recited at column 8, lines 42-45 of Chiba, “[t]he microcomputer 105 analyzes the command (step ST1), and discriminates whether the command is the data write command or data read commands or other (steps ST2, ST3).” Applicant respectfully submits that the microcomputer of Chiba is not discriminating data contents stored in the recording medium. Thus, Applicant respectfully submits that Chiba does not teach or suggest “a discriminator for discriminating the data contents stored in the recording medium.”

In view of the foregoing remarks, Applicant respectfully submits that Chiba does not teach or suggest each feature of independent claim 1. As pointed out in MPEP § 2131, “[to] anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art of reference. Verdegaal Bros. V. Union Oil Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Thus, Applicant respectfully submits that independent claim 1 is in condition for allowance as not being anticipated by Chiba.

Applicant further submits that independent claim 9 should be allowed for at least the same reasons as set forth above with regard to independent claim 1. Independent claim 9 recites features similar to those discussed above with regard to independent claim 1. Specifically, Applicant respectfully submits that Chiba does not teach or suggest “a plurality of selectable contents which are related to an identical reproduction time of the reproduced content”, “storing a plurality of parameters respectively associated with predetermined data contents in a memory”, and “discriminating the data contents stored in the recording medium.” Moreover, Applicant submits that claims 2-8 and 10 are allowable for at least the same reasons as set forth above with regard to independent claims 1 and 9 upon which they depend, respectively, and for the additional features that they recite. Applicant further submits that Kikuchi fails to cure the deficiencies of Chiba with regard to dependent claims 3 and 5-7. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 4 and 8-10 under 35 U.S.C. § 102(e) and the rejection of claims 3 and 5-7 under 35 U.S.C. § 103(a) be withdrawn.

New Claims are Patentable

Applicant adds new claims 11 and 12. Accordingly, claims 1-12 are now pending in this application. Applicant respectfully submits that new claims 11 and 12 are allowable for at least the same reasons as set forth above with regard to independent claims 1 and 9 upon which they depend, respectively, and for the additional features that they recite.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of all rejections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

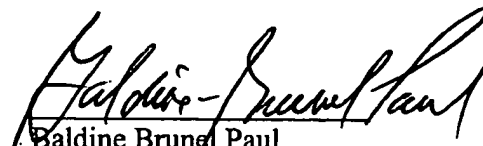
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: July 22, 2004

By:


Baldine Brunel Paul
Registration No. 54,369

Customer No. 09629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001